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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/287,521	04/07/1999	LINDA K. COOK	FUJI-XERX101	6402

23910 7590 05/11/2005

FLIESLER MEYER, LLP  
FOUR EMBARCADERO CENTER  
SUITE 400  
SAN FRANCISCO, CA 94111

EXAMINER

VO, CLIFF N

ART UNIT PAPER NUMBER

2671

DATE MAILED: 05/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/287,521

Applicant(s)

COOK ET AL.

Examiner

CLIFF N VO

Art Unit

2671

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 21 April 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6 and 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 6 is/are allowed.
- 6) ☒ Claim(s) 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Applicant is advised that the Notice of Allowance mailed is vacated. If the issue fee has already been paid, applicant may request a refund or request that the fee be credited to a deposit account. However, applicant may wait until the application is either found allowable or held abandoned. If allowed, upon receipt of a new Notice of Allowance, applicant may request that the previously submitted issue fee be applied. If abandoned, applicant may request refund or credit to a specified Deposit Account.
2. The indicated allowability of claim 8 is withdrawn in view of the newly discovered reference(s) to Cook (U.S. Patent No. 6,657,628). Rejections based on the newly cited reference(s) follow.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 7 of U.S. Patent No. 6,657,628. Although the conflicting claims are not identical, they are not patentably distinct from

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each other because the application's claim merely broaden the scope of the patented claims by not claiming some elements, i.e., causing the autonomous animated character to produce each selected modulated social primitive; modulating the social primitives based on a character profile of the autonomous animated character; and identifying a statistical range. The application's claim is nearly identical in every other aspect to the patented claim 7. More particularly, the patented claim 7 recited a method for designing synthetic characters comprising a step of grouping the selected personality traits into a character profile (col.17, lines 1-2, col.18, lines 14-16), a step of modifying physical characteristics (i.e., range of motion) of the synthesis character based on the character profile (col.17, lines 6-7; col.18, lines 14-15 and 21-26).

It should be noticed that the patented claim 7 fails to teach a step of displaying at least one selectable personality traits (col.17, lines 3-5). Rather, it teaches a step of selecting at least one social primitive from social primitives related to the set of personal traits. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modifying the patented claim 7 by implementing the step of displaying a plurality of personal traits to be selected by the user in order to make it more user-friendly since it would have visually provided all the available options to the user on the display screen which would have made the selection process more easier as now claimed.

Furthermore, it should be noticed that claim 7 of the U.S. Patent No. 6,657,628 is a **method** claim which has all the subject matter of the **system** claim 8 of the instant application. However, using the method claim in claim 7 of the U.S. Patent No.

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6,657,628 to modify/implement the apparatus claim is commonly well known in the art since it would have performed the same function. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the method claim of the U.S. Patent No. 6,657,628 to implement the system claim as now claimed because it would have provided a system performing the same function as now claimed. Therefore, the application's claim simply broader version of the patented claim because claim 7 of U.S. Patent No. 6,657,628 covers and encompasses all the limitations of the claim 8 of the instant application. Moreover, it is well settle that the omission of an element and its function is an obvious expedient if the remaining elements perform the same function as before. In re Karlson, 136 USPQ 184 (CCPA 1963).

***Allowable Subject Matter***

4. Claim 6 is allowed.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CLIFF N VO whose telephone number is 571-272-7651. The examiner can normally be reached on 2nd Monday Off.

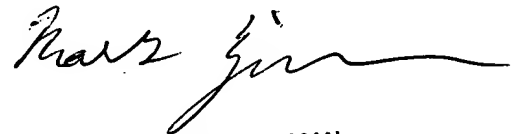
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, MARK K ZIMMERMAN can be reached on 571-272-7653. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

3/28/2005

Cliff Vo



MARK ZIMMERMAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600